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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,316	09/09/2003	Philip Katz		2164

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12 East 41st Street  
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EXAMINER
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OLSZEWSKI, JOAN M

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/658,316

Applicant(s)

KATZ ET AL.

Examiner

Joan M. Olszewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because Figures 6A, 6B, 6C, 6D and 6E are not listed in the brief description of the drawings and Figure 4, the reference character "16" has an incorrect lead line.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "Fig 6" on page 6, line 18. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "31" in Figure 7. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Further, claims 1-8 are replete with 35 USC 112 second paragraph errors and should be totally reviewed and amended as necessary. Below is a listing of some of the problems. Applicant is reminded that no new matter may be introduced and a statement confirming this must be included in Applicant's response.

Claims 1-6, the beginning of the claims start as "A gemstone cut" or "A gemstone". This creates confusion and should be amended so that all claims are consistent.

Claim 1 recites the limitation "said upper facets" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 2, line 2, the phrase "corner facets" is confusing since it is unclear how these relate to the corner facets in claim 1 and thus making the scope of the claim unclear.

Claim 2 recites the limitation "the table" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3, "table 16 and bezel star facet" are confusing since "table 16 is not defined and further the relationship between the gemstone table and bezel star facet has not been claimed, thus making the scope of the claim uncertain.

Claims 5,6 and 7 recite the limitation "said table" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim 6, lines 1 and 2 the phrase "the corner facets" are directed to those below the girdle and set forth in claim 2, accordingly this claim should properly depend from claim 2.

Further since claims 4 and 8 depend from rejected claims these are also likewise rejected.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schachter (US Patent D340,670) and as best understood in light of the 35 USC 112 second paragraph rejection above.

Regarding Claim 1, Schachter discloses a gemstone cut wherein the gemstone cut is a brilliant cut gemstone, comprising: a brilliant cut crown located on an upper side of a girdle, upper girdle facets and upper corner facets, a girdle having a plane and comprising n sides, wherein n is an integer, and corner facets being spaced from the girdle (Figures 1 and 2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachter in view of Friedman et al. (US Patent D447,440) and Wueste (US Patent 6,698,239) and as best understood in light of the 35 USC 112 second paragraph rejections above.

Regarding Claim 2, Schachter discloses all the claimed features as discussed in the rejection above except for a pavilion located on a lower side of the girdle comprising lower girdle facets, bezel star facets and corner facets or this arrangement having an angle between the table and the lower girdle facets of 50-60°. However, Friedman et al. teach a pavilion located on a lower side of a girdle comprising the details stated above (Figure 3)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the gemstone of Schachter by substituting the pavilion located on the lower side of a girdle having lower girdle facets, bezel star facets and corner facets as taught by Friedman et al. in order to provide a different choice of pavilion designs.

Further, Wueste teaches the use of a diamond lower pavilion having an angle between the table and the lower girdle facets of 40-43° (table 1) which is considered close to the claimed 50-60° since the optimization of proportions in the prior art is a design consideration within the skill of the art (In re Reese, 290 F. 2d 839, 129 USPQ 402 (CCPA 1961). Re-claim 3, Wueste shows the angle between the table and bezel star facet is between 42-45° (Wueste Table 1). Re- claim 6, Wueste shows the angle

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between the table and the corner facets to be between 43-46° (Wueste Table 1 and Figure 4C). Re- claim 7, Wueste shows an angle between the table and the upper girdle facets to be between 32-35° (Wueste Table 2). Re- claim 8, Wueste shows an angle between the girdle and the upper corner facets to be between 29-32° (Wueste Table 2 ).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the angles between the various facets in the combination of Schachter and Friedman et al. to be within the claimed range as taught by Wueste in order to improve appearance of the gemstone.

Regarding Claims 4 and 5, Schachter teaches n is equal to 8 (Schachter, Figure 1) and wherein the table is shaped an equilateral octagon (Schachter, Figure 1).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hedgecock (D330,344), Kaplan (D330,873), d'Haene (D348,024), Turner et al. (D439,542), Alvarado (D411,133), Bamminger et al. (2002/0007648), Cheng (6,401,489), Bamminger et al. (6,422,039), Kawabuchi et al. (2002/0043078), Thatcher (D476,258), Yoshida (D478,529) and Namdar (D478,837).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan M. Olszewski whose telephone number is 703-305-2693. The examiner can normally be reached on Monday-Thursday (5:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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